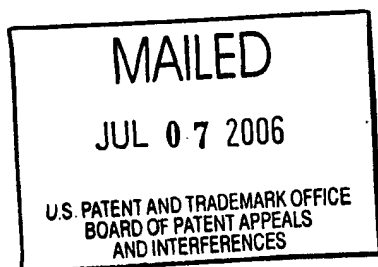


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. FORE SR., JAMES R. FORE, II and
LLOYD YOUNG



Appeal No. 2006-0125
Application 10/086,316

ON BRIEF

Before FRANKFORT, LEVY and NAPPI, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 19 and 21 through 24. Claims 1 through 9 stand allowed. Claim 20, the only other claim in the application, has been indicated to contain allowable subject matter, but currently stands objected to as being dependent from a rejected base claim.

Appellants' invention relates to a pay-out tube used in conjunction with cable boxes and containers for facilitating the feeding of cable, wire and other rope-like materials from such boxes and containers, and to a method of securing an end of a cable

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exteriorly of a cable container housing a cable winding. Independent claims 10, 14, 17 and 22 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix attached to appellants' brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Heyman	3,516,111	Dec. 22, 1967
Newman et al. (Newman)	4,057,203	Nov. 8, 1997
Fore	5,368,245	Nov. 29, 1994
Bass et al. (Bass)	5,520,347	May 28, 1996

Claims 10 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fore.

Claims 10 through 16 and 22 through 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fore in view of Heyman.

Claims 17 through 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bass in view of Newman.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by appellants and the examiner regarding those rejections, we make reference to the final rejection (mailed January 23, 2004) and answer (mailed August 4, 2004) for the examiner's reasoning in support of the rejections, and to appellants' brief (filed May 26, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the rejection of claims 10 and 22 under 35 U.S.C. § 102(b) as being anticipated by Fore, we note that the examiner's statement of this rejection is found on pages 2-3 of the final rejection. For the reasons set forth on pages 4-7 of the brief, we agree with appellants that Fore does not anticipate the pay-out tube of claim 10, or the pay-out tube and cable retainer as defined in claim 22 on appeal.

Claims 10 and 22 are both readable on the embodiment seen in Figures 7 and 8 of appellants' application drawings wherein a cable retainer (60) having flexible segments (63a-63d) is part of the pay-out tube and is used to retain a cable or wire end when the cable or wire end is inserted between or within one of the slits (62a, 62b) and further pushed between the inner wall (11b) of the collar (12) and the exterior of the wall of the container (49). See pages 6 and 7 of appellants' specification.

The examiner's reliance on Fore to teach a cable retainer of the type claimed in the present application having "a surface divided by one or more slits that form at least two sections with at least one of the two sections being deflectable and which deflect at least partially open in response to the end of the cable being inserted between the sections" as in claim 10 on appeal, and defined by similar language in claim 22, in our view, is not well founded. Fore (col. 3, lines 66-67) specifically notes that the cable clip (36) is "formed on the outer surface of the outer flange 32" of the locking collar (14) and, more specifically, that the clip is preferably integrally molded with the locking collar. Fore goes on to indicate (col. 4, lines 3-6) that the clip (36) "can be pulled open and a cable can be slipped thereunder in such a fashion that the cable clip 36 will retain the terminal end of the cable against the outer face of the outer flange 32." Clearly, the cable clip of the pay-out tube in Fore and the cable retainer associated with appellants' pay-out tube defined in claims 10 and 22 on appeal are significantly different from one another both structurally and functionally. As appellants urge in the brief, the clip of Fore is not a section of a surface, defined by a slit in the surface; it is expressly described as a member formed on the outer face of the outer flange (32) and spaced apart from the outer surface, that holds a cable or wire by pressing it against the outer surface.

For the above reasons, we will not sustain the examiner's rejection of claims 10 and 22 under 35 U.S.C. § 102(b) as being anticipated by Fore.

The next rejection for our review is that of claims 10 through 16 and 22 through 24 under 35 U.S.C. § 103(a) as being unpatentable over Fore in view of Heyman. In this instance, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to use the cable container and two-piece pay-out tube described in Fore in association with a bushing like that in Heyman mounted in an aperture in a panel as taught in Heyman so as to retain and protect a cable or wire removed from the container of Fore and passed through a wall or panel during installation of the cable or wire. Although appellants urge that there is no motivation to combine the teachings of Fore and Heyman, we agree with the examiner that it would have been obvious to one of ordinary skill in the art to use the invention as described in Fore and that described in Heyman together, each for its own intended purpose, during installation of cable from the container in Fore in walls or panels carrying bushings like those in Heyman.

Where we disagree with the examiner is in his conclusion that the combination of Fore and Heyman as urged in the final rejection and answer would result in a "pay-out tube" like that defined in

claim 10 on appeal or a "pay-out tube and cable retainer" as set forth in claim 22 on appeal. In our view, both of those claims require the cable retainer to be part of the pay-out tube itself and not a separate element used independently of the pay-out tube as is the case in the examiner's combination of the applied patents to Fore and Heyman. Thus, we will not sustain the examiner's rejection of independent claims 10 and 22, or dependent claims 11 through 13, 23 and 24, under 35 U.S.C. § 103(a).

Independent claim 14 is directed to a method of securing an end of a cable exteriorly of a cable container housing a cable winding, the method comprising the steps of

threading cable from the winding through a wall of the cable container; and retaining an end portion of the cable outside of the cable container by inserting the end portion of the cable through a slitted surface that defines at least two sections.

Like the examiner, it appears to us that one of ordinary skill in the art using the invention as described in Fore and that described in Heyman together, each for its own intended purpose, during installation of cable from the container in Fore in walls or panels carrying bushings like those in Heyman would naturally perform the method as broadly set forth in appellants' claim 14. That is, during cable installation, one would thread cable from the winding in Fore's cable container through a wall (42) of the cable

container (via the pay-out tube (10) of Fore), and subsequently retain an end portion of the cable outside of the cable container by inserting the end portion through a slitted surface of a bushing like that in Heyman, mounted in a wall or panel, which bushing defines at least two deflectable sections (7) that grasp the cable, protect it against abrasion, and further tend to center the cable.

Contrary to appellants' assertions in the brief (pages 11-12), claim 14 does not recite that the cable end is retained in a "pay-out tube retainer," or that the end of the cable retained is the end of the cable dispensed from the cable container, which is only secured by the retainer following dispensing of a preceding length of cable. There is no pay-out tube required in claim 14 and thus no "pay-out tube retainer." Nor does claim 14 require that the retained end portion of the cable be that remaining after a preceding length of cable has been dispensed, i.e., the end portion of the cable still protruding from the wall of the cable container after a preceding length of cable has been cut off. In our view, the broad language of claim 14 encompasses retaining an end portion of a length of cable already cut from the cable threaded through the wall of the cable container, as would be the case in Heyman.

Since appellants have not demonstrated any error in the examiner's obviousness rejection of claim 14, we will sustain the rejection of that claim, and dependent claims 15 and 16, under 35

U.S.C. § 103(a). Appellants' brief at page 4 indicates that claims 14-16 stand or fall together. Thus, claims 15 and 16 fall with claim 14.

The last of the examiner's rejections for our review is that of claims 17 through 19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Bass in view of Newman. In this case, the examiner has determined that Bass discloses a pay-out tube used with a cable box including cable or wire (13) arranged in a stacked figure-8 configuration, wherein the pay-out tube comprises a molded synthetic resin tube portion (33) for receiving and guiding cable or wire and that includes a series of spaced-apart, longitudinally disposed, radially outwardly extending ribs (66) integrally molded with the tube wall and extending from the wall such that a thickness of the individual ribs exceeds the thickness of the tube wall. What the examiner finds lacking in Bass is any teaching that the tube portion (33) have a generally elliptical configuration, as is required of the pay-out tube defined in claim 17 on appeal.

To address that deficiency in Bass, the examiner looks to Newman, noting that it teaches a pay-out tube for cable or wire arranged in a container in a figure-8 configuration, wherein the tube portion (8) has an elliptical (oval) configuration so as to better fit the space provided in the coil of figure-8 wound material in the container. From the combined teachings of Bass and Newman,

the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to make the cross-section of the tube portion (33) of Bass elliptical as taught by Newman so as to adapt it to better fit the space provided within the coil of figure-8 wound cable therein.

We agree with the examiner. Contrary to appellants' argument in the brief (page 12-13), the ribs (66) of Bass meet the terms of claims 17 through 19 on appeal, i.e. they provide a series of spaced-apart, non-intersecting, longitudinally disposed, radially outwardly extending ribs integrally molded with the tube wall and extending from the wall such that a thickness of the individual ribs exceeds the thickness of the tube wall. Appellants' assertions regarding the fact that other ribs (67) intersect individual ribs (66) at right angles to the ribs (66), is of no moment, since the open-ended "comprising" language of claim 17 does not exclude other ribs from being part of the tube portion. As for the argument that there is no suggestion or motivation for the combination of Bass and Newman, we again agree with the examiner that the teachings of Newman provide ample suggestion to support that combination. See particularly, column 1, lines 16-32, of Newman, wherein it is noted that an oval (elliptical) configuration for the tube portion fills the hole in the figure-8 wound cable within the container to a greater degree and provides a greater amount of support for the

cable material on either side of the hole, and at the same time allows some freedom of movement of the wound material, assuming that its diameter is less than the minor axis of the elliptical oval payout tube.

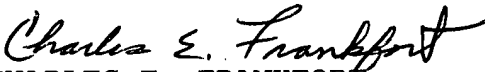
On the basis of the foregoing, we will sustain the examiner's rejection of claims 17 through 19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Bass in view of Newman. We again note that appellants have grouped the claims to "stand or fall together" (brief, page 4), and that dependent claims 18, 19 and 21 thus fall with claim 17.


In summary, we have refused to sustain the examiner's rejection of claims 10 and 22 under 35 U.S.C. § 102(b) as being anticipated by Fore, or that of claims 10 through 13 and 22 through 24 under 35 U.S.C. § 103(a) as being unpatentable over Fore in view of Heyman. However, we have sustained the examiner's rejection of claims 14 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Fore in view of Heyman, and that of claims 17 through 19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Bass in view of Newman. Accordingly, the decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART


CHARLES E. FRANKFORT)
Administrative Patent Judge)


STUART S. LEVY)
Administrative Patent Judge)


ROBERT E. NAPPI)
Administrative Patent Judge)

BOARD OF PATENT
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